

REMARKS

Applicants are in receipt of a Notice of Non-Compliant Amendment with regard to the matter captioned above. That paper was dated July 16, 2007, and a time period of one month or thirty days, whichever is longer, from that date was imposed as a deadline for re-submitting the corrected section in compliance with the rules. It is submitted that the action taken hereby is timely and adequate to obviate the non-compliance cited by the examiner.

The above amendments and following remarks were originally submitted in response to the official action of the Examiner mailed September 2, 2005. This amendment is deemed to fully respond to all objections and rejections of the Examiner. Thus, claims 1-20, being all pending claims, are now expected to be in condition for allowance. Entry of this amendment and reconsideration to that end is respectfully requested.

The Examiner has newly objected to the specification under MPEP 608.01 as containing an "embedded hyperlink and/or other form of browser-executable code". In response thereto, page 2 of the specification has been amended above. The Examiner has made numerous other objections of alleged informalities. In response thereto, pages 2, 3, 17, 18, and 19 have been amended above.

The Examiner has objected to claims 9 and 10 alleging dependence from themselves. In response thereto, claims 9 and 10 have been amended above.

Claims 5, 9, 14, 15, and 20 have been rejected under 35 U.S.C. 112, first paragraph, regarding the use of the term "further comprises". Though rejection of such a routinely utilized term in the profession is deemed highly irregular, claims 5, 9, 14, 15, and 20 have been above amended to remove the term "further comprises".

Claims 1-2, 5-6, and 10 have been rejected under 35 U.S.C. 112, second paragraph, as indefinite. In response thereto, claims 1-2, 5-6, and 10 have been amended to utilize the term "client work station" which is employed throughout Applicants' specification (see for example page 7, lines 2-14).

Claims 1-8, 11, 13-14, 16, and 19 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This ground of rejection is respectfully traversed.

Apparently, the Examiner has confused "definiteness" with "breadth", because he states that he is "unclear" whether certain claimed elements are "software or hardware". To the extent that a particular element could be either "software or hardware" goes to the breadth of the claim rather than the definiteness. That the Examiner recognizes that a particular element could be either "software" or "hardware" specifically shows that the element is definite but should be broadly

construed to cover either a "software" or a "hardware" embodiment.

Of course, it is important in Applicants' specification to illustrate a preferred embodiment of such an element which could be either "software" or "hardware". For example, claim 1 recites a "client work station". An explanation of this term may be found at page 14, lines 9-14. Similarly, claim 1 recites an "enterprise server". The preferred embodiment of this term is defined at page 15, lines 2-5. The nature of the preferred mode of an "adapter" may be found in the specification at page 8, lines 17-20. Though the Examiner will see that the preferred mode of each of the claimed elements is disclosed in detail, it is the nature of the U.S. Patent law not to restrict Applicants' claimed invention to the preferred embodiments.

Claim 1 has been rejected under 35 U.S.C. 112, second paragraph, as being indefinite, because "the Examiner is unclear what the difference is between one of said plurality of protocols and an enterprise protocol". This ground of rejection is respectfully traversed because the Examiner has again confused "breadth" with "definiteness". Applicants could certainly narrow claim 1 to more specifically define this difference, but are not required to do so under 35 U.S.C. 112, second paragraph.

Claims 4 and 5 have been rejected under 35 U.S.C. 112, second paragraph, in view of the terms "industry standard" and

"industry compatible". In response thereto, these words have been deleted.

Claim 5 has been rejected under 35 U.S.C. 112, second paragraph, in view of an alleged improper use of a trademark. In response thereto, claim 5 has been amended.

Claim 6 has been rejected under 35 U.S.C. 112, second paragraph, in view of the use of the term "responsively coupled". In response thereto, claim 6 has been amended to remove this term.

Claims 1, 3, 6, 7, 8, 11, 13, 16, and 19 have been rejected under 35 U.S.C. 112, second paragraph, in view of the term "publicly accessible". In response thereto, these claims have been amended to remove the term.

Claims 1-5 have been rejected under 35 U.S.C. 112, second paragraph, for use of the term "the improvement". Apparently, the Examiner is unfamiliar with the form of the Jepson-type claim specifically authorized in 37 C.F.R. 1.75(e) 2 and having examination procedures defined in MPEP 608.01(m) which provides:

608.01(m) Form of Claims

The form of claim required in 37 CFR 1.75(e) is particularly adapted for the description of improvement-type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

Therefore, for the convenience of the Examiner, claims 1-5 have been amended to render them no longer Jepson-type claims.

Claims 1-10 and 16-20 have been rejected under 35 U.S.C. 101 as being allegedly directed to non-statutory material. This ground of rejection is respectfully traversed.

In support of his rejection, the Examiner states:

Claims 1-10 and 16-20 seem to be directed to software *per se*, and not towards any embodiment of hardware.

Quite apart from the fact that this finding is clearly erroneous¹ and contrary to controlling law², it specifically contradicts the Examiner previous findings. In paragraph 14 of the pending official action, the Examiner expressly states:

....the claims seem to be directed towards a hardware deinfition of these terms.

The rejection under 35 U.S.C. 101 is respectfully traversed.

Claims 1, 6, 11, and 16 have been rejected under the judicially created doctrine of obviousness-type double patenting. This rejection is deemed provisional, because the rejected claims have not yet been found patentable. Therefore, the rejection is not deemed ripe, but will be addressed at such time as the rejected claims are otherwise found allowable.

¹Claims 1-5, 6-10, and 16-20, as amended, claim a data processing system and/or apparatus having both hardware and software components in the preferred embodiments as explained above.

²The Examiner has not and indeed cannot cite any authority in support of this position.

Claims 1-3, 6-7, 11-13, and 16-19 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,790,809, issued to Holmes (hereinafter referred to as "Holmes"). This ground of rejection is respectfully traversed for the reasons provided below.

The standards for a finding of anticipation during examination are specified in MPEP 2131, which provides in part:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH
EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). **"The identical invention must be shown in as complete detail as is contained in the ... claim."** *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). (emphasis added)

The rejection is respectfully traversed because Homes does not show "the identical invention....in as complete detail as is contained in the claim[s]" as required by MPEP 2131.

It is the essence of Applicants' invention as disclosed and claimed that the claimed "client work station" operates and communicates in one format and the claimed "enterprise server" operates and communicates in another which is incompatible with the "client work station" format. Thus, the invention as disclosed and claimed includes structure for conversion between the "client work station" format and the "enterprise server" format.

Holmes provides no such conversion. Apparently, the requesting client and honoring server of Holmes both operate and communicate using the same format. However, Holmes is directed to the task of transferring messages between the requesting client and honoring server via incompatible intermediate servers. The approach utilized by Holmes is to "encapsulate" the messages within a message shell which can be transferred via the incompatible intermediate servers.

Holmes summarizes this process in his Abstract stating:

....each **client** capable of initiating an application in which a **related compatible server** is involved. Communication between the clients and servers involve a first registry process including the acceptance of application specific messages from a client, destined for a preselected server, and encapsulating them into standard registry specific messages.....The second registry accepts the translated message and converts them from protocol format to **the original application specific format for use by the preselected compatible server**. (Emphasis added)

In other words, the requesting client and honoring server are required to be compatible in format.

Claim 1, for example, is limited by:

a first client work station for entering a first transaction request, wherein said first transaction request has a first one of a plurality of protocols
an enterprise server for responding to said first transaction request using **an enterprise protocol which is not one of said plurality of protocols**
(emphasis added)

Thus, in Applicants' claimed invention, the formats are different, necessitating the claimed structure (i.e., "generic

gateway") to perform the conversion process which is neither needed nor found in Holmes. The rejection of amended claim 1, and all claims depending therefrom, is respectfully traversed.

Claim 2 depends from claim 1 and is further limited by "adapters" interposed between the claimed "client work stations" and the claimed "generic gateway". Holmes, of course, does not have this limitation, because it does not make the conversion as explained above. However, instead of allowing claim 2 for failure to meet the requirements of MPEP 2131, the Examiner somehow finds the claimed "adapters" inherent without meeting the requirements of MPEP 2112. Therefore, the rejection of claim 2 is respectfully traversed for failure of the Examiner to meet his burden under MPEP 2112.

Claim 3 depends from claim 2 and further limits the claimed "network". As shown above, Holmes cannot meet the limitations of claim 2 from which claim 3 depends. Therefore, Holmes cannot meet the further limitations of claim 3. The rejection of claim 3 is respectfully traversed.

Claim 5 depends from claim 4 and provides further limitations. The Examiner has admitted that Holmes does not anticipate claim 4 from which claim 5 depends. Therefore, Holmes cannot anticipate claim 5 as a matter of law. The rejection of claim 5 is respectfully traversed as contrary to controlling law.

Claim 6 is an independent apparatus claim having various limitations (e.g., "input view file", "generic server",

etc.) which are neither found in claim 1 nor in Holmes.

Therefore, the examination is inadequate as a matter of law wherein the Examiner states:

The rejection of claim 1 is applied against claim 6.

It is important to note that these additional limitations are clearly not found in Holmes, because the requesting client and honoring server of Holmes operate and communicate using the same format. The rejection of amended claim 6, and all claims depending therefrom, is respectfully traversed.

Claim 7 depends from claim 6 and is further limited by "adapters" not found in Holmes. The Examiner admits that these structures are not expressly found in Holmes, because Holmes does not need to perform the claimed conversion. Therefore, the Examiner makes a finding of "inherency" without complying with the requirements of MPEP 2112. The rejection of claim 7 is respectfully traversed.

Claim 11 is an independent method claim having four key steps. Notwithstanding the differences in claimed limitations and the differences in statutory and judicial standards of patentability between apparatus and method claims, the Examiner states:

The limitations of this claim are substantially the same as the limitations of claims 1 and 6. The rejections of claims 1 and 6 are applied against claim 11.

Therefore, the rejection of amended claim 11, and all claims depending therefrom, is respectfully traversed for the reasons stated above and as a matter of law for inadequate examination.

Claim 12 depends from claim 11 and is further limited by:

Transferring said converted and processed first service request and second service request from said generic gateway to an end service provider.

Instead of addressing the claimed invention, the Examiner states:

Holmes, column 3, discloses transmitting service requests over a network to a recipient after converting the request.

In other words, because Holmes does not meet the limitations of claim 12, the Examiner attempts to rewrite the claim in accordance with Holmes. The rejection of claim 12 is respectfully traversed for failure of the Examiner to address the limitations of the claimed invention.

Claim 13 depends from claim 12 and further limits the claimed "network". As shown above, Holmes cannot meet the limitations of claim 12 from which claim 13 depends. Therefore, Holmes cannot meet the further limitations of claim 13. The rejection of claim 13 is respectfully traversed.

Claim 16 is an independent apparatus claim having "means-plus-function" limitations. As such it is to be examiner in accordance with MPEP 2181 et seq. Instead of complying with controlling law, the Examiner states:

The limitations of claim 16 are substantially the same as the limitations of claim 1. The rejection of claim 1 is used against claim 16.

In addition to the issues discussed above, the rejection of amended claim 16, and all claims depending therefrom, is respectfully traversed for failure of the Examiner to properly examine the claimed invention.

Claim 17 depends from claim 16 and is further limited by "connectors". Claim 18 depends from claim 17 and is further limited by the relationship of the "connectors" to the "adapters". In apparently rejecting claims 17 and 18, the Examiner states:

The limitations of claims 17-18 are substantially the same as the limitations of claim 2.

In addition to inadequacy as a matter of law for the reasons provided above, the Examiner's statement is clearly erroneous. Claims 17 and 18 explicitly require the claimed "connectors" which are not limiting of claim 2. The rejection of claims 17 and 18 is respectfully traversed as based upon clearly erroneous findings of fact and inadequate application of controlling law.

Claim 19 depends from claim 18 and further limits the claimed "network". As shown above, Holmes cannot meet the limitations of claim 18 from which claim 19 depends. Therefore, Holmes cannot meet the further limitations of claim 19. The rejection of claim 19 is respectfully traversed.

Claims 4 and 8 have been rejected under 35 U.S.C. 103(a) as being obvious in view Holmes. This ground of rejection is respectfully traversed for failure of the Examiner to make any of the three showings required by MPEP 2143.

To make a *prima facie* case of obviousness, MPEP 2143 requires the Examiner to provide evidence and argument showing: 1) motivation to make the alleged modifications; 2) reasonable likelihood of success of the alleged modified reference; and 3) all claimed elements within the alleged modified reference. The Examiner has failed to make any of these three required showings. Therefore, because the Examiner has not made a *prima facie* case of obviousness, Applicants need not and indeed cannot offer appropriate evidence and argument in rebuttal.

In alleging motivation, the Examiner states:

It would have been obvious to one of ordinary skill in the art to put any portion or combination of the elements in the Holmes invention in any type of housing. (Emphasis added)

This statement is clearly erroneous as a matter of law. Having no "generic gateway" or "middleware" as claimed, it is not even plausible to suggest that these elements could be housed by Holmes in any particular manner.

The third showing required by MPEP 2143 is that all claimed elements are present. The Examiner specifically admits that not all of the claimed elements are present in Holmes. Therefore, the rejection of claims 4 and 8 is respectfully

traversed for failure of the Examiner to make any of the three showings required by MPEP 2143 to present a *prima facie* case of obviousness.

Apparently, claims 9 and 10 have been found allowable over the prior art of record. Therefore, it is assumed that claims 9 and 10 will be allowed in view of the amendments noted above to correct various alleged informalities.

Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

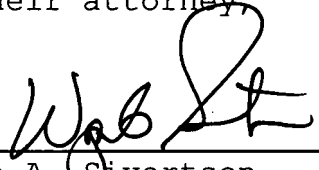
Please charge any deficiencies or credit any overpayment to Deposit Account No. 14-0620.

Respectfully submitted,

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By their attorney,

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